

REMARKS

Claims 1-22 are currently pending in the application. All claims stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Claims 1-13 and 15-22 stand rejected under 35 U.S.C. § 103 as obvious over U.S. Patent No. 6,897,786, to Kalt et al. (Kalt), in view of the New York Times article written by Matthew Purdy (Turnpike). Claim 14 stands rejected under 35 U.S.C. § 103 as obvious over Kalt in view of Turnpike, and further in view of U.S. Patent No. 6,267,529, to Mudryk et al. (Mudryk).

Reconsideration of the rejection of claims 1-22 is requested.

The Examiner argues that the claimed method is not either: (1) tied to a particular machine or apparatus; or (2) required to transform underlying subject matter. Applicant respectfully traverses this rejection.

The method claims all require a support upon which specific viewable information is provided. Thus, the method is clearly tied to a particular apparatus. In light of this, withdrawal of the claims under 35 U.S.C. § 101 is requested.

It is respectfully submitted that the prior art relied upon by the Examiner not only does not make the claimed subject matter obvious, but on its own demonstrates that the claimed subject matter is non-obvious.

Kalt is relied upon merely for the disclosure of a support with information thereon relating to the public right-of-way. This basic technology is acknowledged to be well known as signage of this type has existed on right-of-ways for many decades. As

acknowledged by the Examiner, Kalt does not disclose the placement of advertising information unrelated to the public right-of-way on the same support.

Turnpike relates to the concept of generating revenue by having a Turnpike Authority erect its own two-sided billboards and renting them to other entities.

Turnpike addresses the issue of how such billboards would change the feel of the public roadways and detract from their appearance. With the system proposed by Turnpike, one would be bombarded not only with billboards on private properties but with billboards between the normal signage relating to the right-of-way and the billboards on the private properties.

With the claimed invention, there are several advantages. First of all, by placing advertising information on existing supports on which there is information pertaining to the public right-of-way, the method can be practiced without adding unsightly and obtrusive structure. Second, one can use the back of the existing signage and space thereon that currently: a) is strategically situated for viewing by vehicle traffic; and b) is not used for any other purpose. Third, by reason of offering advertising space in conjunction with supports owned and maintained by a governmental entity, that governmental entity can offer to place, change and maintain an advertising structure for an entity without any significant additional cost or inconvenience to the governmental entity. Fourth, income can be derived both from a regular "rental fee", as well as fees that may be charged for changing and maintenance of the advertising components for the entity to which they relate.

While Turnpike recognizes an opportunity for a governmental entity to generate revenue through signage offered to private entities, the proposal therein of the

two-sided billboards adds yet another level of signage to the existing signage for the right-of-way and adjacent signage that is viewable from the right-of-way but on private property. This additional signage further detracts from the aesthetics of the landscape. Additionally, the maintenance of such signage could not be carried out in conjunction with that on the supports on the right-of-way.

In spite of the existence of extensive signage for right-of-ways and separate signage for private advertising, and in spite of the strong push towards maintaining the aesthetic appearance of landscape adjacent to right-of-ways, and further the desirability of allowing governmental agencies to generate revenue through rented signage as disclosed by Turnpike, to date the claimed method is not known to the Applicant to be practiced on any public right-of-way. Yet it addresses all of the above concerns with little, if any, down side.

Turnpike has a November 7, 1999 publication date and sets forth numerous objectives and existing problems. Almost ten years later, the fact that the present method, that addresses all the discussed objectives, is not being practiced clearly suggests that it is not obvious.

Applicant submits that the combination of Kalt and Turnpike is not obvious and, even if the combination was made, the claimed subject matter does not result.

Kalt discloses only one-sided signage of the type that is well known and in existence on virtually all public highways.

Turnpike discloses two-sided billboards, with advertising on both sides.

Applicant respectfully submits that is illogical to combine a one-sided sign with information relating to the right-of-way with a two-sided billboard with advertising on

both sides. To mesh these concepts, one would have to depart significantly from the combined teachings to arrive at what Applicant has claimed. Applicant respectfully submits that this redesign would result only from the improper use of hindsight, using Applicant's disclosure as a template.

In conclusion, the combination of Kalt and Turnpike is not obvious and even if made, to arrive at the claimed method, a significant departure from the disclosure in each must be made with no motivation for doing so other than Applicant's own teachings.

The subject matter of independent claims 1 and 13 is thus believed allowable over the applied art.

The remaining claims depend directly or indirectly from one of claims 1 and 13 and recite further significant limitations to further distinguish over the applied art.

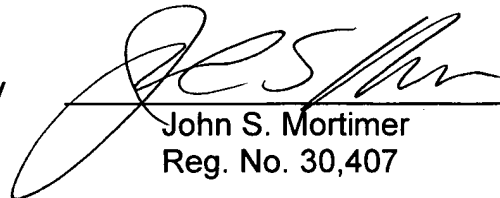
Mudryk is relied upon only for the disclosure therein of a roadway configuration that relates to claim 14. Mudryk does not alone, or in combination with Kalt or Turnpike, teach or make obvious the method recited in either of claims 1 or 13.

Reconsideration of the rejection of claims 1-22 and allowance of the case
are requested.

Respectfully submitted,

WOOD, PHILLIPS, KATZ,
CLARK & MORTIMER

By



John S. Mortimer
Reg. No. 30,407

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500 West Madison Street
Suite 3800
Chicago, IL 60661-2562
(312) 876-2113